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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,797	06/18/2001	Jan G. Jaworski	07148-064002	3128
26191	7590	12/03/2003	EXAMINER	
FISH & RICHARDSON P.C. 3300 DAIN RAUSCHER PLAZA 60 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402			MCELWAIN, ELIZABETH F	
		ART UNIT	PAPER NUMBER	
			1638	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/883,797	JAWORSKI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Elizabeth F. McElwain	1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 June 2003 and September 13, 2003
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 33-37 and 40-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 33-37, 40-51 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

The amendments filed June 9, 2003 and September 13, 2003 have been entered.

Claims 1-32, 38 and 39 have been cancelled.

Claims 33, 40, 41 and 48 have been amended.

Claims 41-51 have been newly submitted.

Claims 33-37 and 40-51 are pending and are examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejections that are not restated below have been withdrawn.

***Double Patenting***

1. Claims 33-37 and 40-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim8-20, 44, 51 and 58 of U.S. Patent No. 6,307,128 for the reasons stated in the last office action.
2. Applicants' arguments filed June 9, 2003 have been fully considered but they are not persuasive. Applicants state that a Terminal Disclaimer will be filed when allowable claims are identified. The Examiner maintains that the claims will not be allowable until a Terminal Disclaimer is filed. Please note that a delay in submission of a Terminal Disclaimer will result in a delay in the issuance of a Notice of Allowability, as the Terminal Disclaimer is required before the Notice of Allowability can be issued.

***Claim Rejections - 35 USC § 112***

3. Claims 33-37 and 40-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in the last office action.

4. Applicant's arguments filed June 9, 2003 have been fully considered but they are not persuasive. Applicants argue that the rejection is improper given that the claims have been amended to recite the functional activity of the polypeptide. The Examiner maintains that a written description has not been provided that sets forth the structural features that are necessary in the claimed polypeptide that would confer the claimed functional activity. There is still a lack of written description with regard to which sequences that fall within the 80% identity range would have beta-ketoacyl synthase activity.

5. Claims 33-37 and 40-51 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as stated in the last office action.

6. Applicant's arguments filed June 9, 2003 have been fully considered but they are not persuasive. Applicants argue that the rejection is improper given that applicants have amended the claims to recite that the polypeptide would have beta-ketoacyl synthase activity, and the

specification teaches assaying for beta-ketoacyl synthase activity. Applicants also state that the DeLuca reference reports successful results in redirecting fatty acid biosynthesis products from long chain fatty acids to medium chain fatty acids, and thus supports enablement of the claimed invention. Applicants also state that the Van de Loo and Broun references are not relevant to the present claims since they are drawn to enzymes having different activities. Therefore, applicants assert that it would not require undue experimentation to practice the claimed invention.

The Examiner maintains that the claims encompass a multitude of sequences, while the specification does not demonstrate any having beta-ketoacyl synthase activity. The Examiner maintains that the cited references are relevant in establishing unpredictability of the art. Applicants have not taught that any sequences that fall within the scope of the claims encode polypeptides having beta-ketoacyl synthase activity. As stated in the last office action, it would require undue experimentation to identify any sequences that fall within the scope of the claims.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

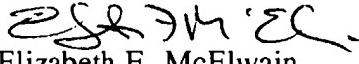
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory

period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is 703-308-1794. The examiner can normally be reached on increased flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Elizabeth F. McElwain  
Ph.D. Level Examiner  
Art Unit 1638

EFM